

Appl. No. : 10/075,059
Filed : February 11, 2002

REMARKS

Claims 1-3 and 8 were pending in the application, were previously allowed, and then withdrawn from issue. Claims 4-7 were previously cancelled without prejudice. Hence, Claims 1-3 and 8 are again presented herein for examination.

Section 103 Rejections

Per pages 2-4 of the Office Action, the Examiner has rejected Claims 1-3, and 8 under 35 U.S.C. §103(a) as being unpatentable over the admitted prior art in view of Schantz (US Patent No. 3,916,139) and Seidler (US Patent No. 4,737,115). Applicant herein respectfully traverses these rejections.

Claim 1 - As for independent Claim 1, the Examiner commented that: “*Regarding the limitation that the width of the plate would be slightly less than the width of the notch, it is inherent that the width of the plate would have been slightly less than the width of the notch or aperture.*” After reviewing the cited references of ‘139 Patent and ‘115 Patent, and the specification and the drawing of the present invention, the Applicant respectfully submits that the limitation of the width of the plate being slightly less than the width of the notch is not an inherent feature. The reasons supporting this conclusion are described as follows.

The esteemed Examiner states that “*The act of separating the plate from the notch results in the plate width being less than the notch width. Furthermore, it is not that such width may result from separation of the plate and notch, but rather it is the necessary and incontrovertible result of the separation of the plate and notch. See MPEP section 2112; In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999).*”

In response to these comments by the Examiner, the applicant respectfully submits that the plate width being slightly less than the notch width is the desired result of the present invention, but not an inherent feature simply caused by the act of separating the plate from the notch. Three (3) feasible alternatives, i.e., that the plate width is slightly less than, equal to, or slightly larger than the notch width, are described and analyzed in the previous presented Amendment and Response to Office Action filed on July 26, 2004. This prior Response

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specifically points out the advantages/disadvantages of these three alternatives so as to show that the plate width being slightly less than the notch width is the chosen feature, which is important to practicing the present invention, instead of merely an accident or byproduct of separating the plate from the notch as proffered by Examiner. The main features of these three alternatives are again summarized as follows to elaborate on their respective advantages/disadvantages.

1) If the width of the plate is slightly larger than the width of the notch, it has the advantage of fixing the bare wire well thereunder, but has the disadvantage of not fastening the bare wire well thereunder.

2) If the width of the plate is equal to the width of the notch, it has the advantage of fixing the bare wire well thereunder, but has the disadvantage of causing the cutting damage of the bare wire and not fastening the bare wire well thereunder.

3) If the width of the plate is slightly less than the width of the notch, it has the advantages of avoiding the drawback of cutting by the two edges of the projecting plate and the second strip, and having a relatively appropriate clamping force for fastening the bare wire well thereunder.

Applicant notes that the plate width of the recited invention may comprise at least five (5) distinct states: (i) the plate width being comparatively much larger than the notch, (ii) slightly larger than the notch, (iii) equal to the notch, (iv) slightly less than the notch, or (v) significantly less than the width of the notch. These five states can be achieved through any number of different procedures of manufacturing irrespective of the original plate width, and also irrespective of whether the act of separating the plate from the notch results in the plate width being less than the notch width. For example, Applicant might alter the geometry or width of the plate after it has been cut out (e.g., to broaden it). Similarly, Applicant might attach the plate (such as via welding or brazing or other process) *after* the notch has been formed. Myriad other processes for constructing the recited apparatus are readily envisaged.

By the same token, irrespective of whether the plate width being slightly less than the notch width is the "necessary and incontrovertible result of the separation of the plate and notch" as previously noted by the Examiner, the plate width could finally be made (i) much larger than, (ii) slightly larger than, (iii) equal to, (iv) slightly less than, or (v) much less than the

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width of the notch through the aforementioned manufacturing procedures. Since Claim 1 is not a "product by process" claim but rather merely recites an apparatus, literally any process (including those other than that cited by the Examiner) could be used to produce the claimed apparatus. Hence, the Examiner's argument regarding inherency is based on the erroneous assumption that Applicant is limited to using that one process only.

Thus, irrespective of whether the plate width being slightly less than the notch width is the necessary and incontrovertible result of the separation of the plate and the notch or not, the recited feature of Claim 1 that the plate width be slightly less than the notch width is not an inherent feature simply derived from the separation of the plate and the notch.

Applicant further respectfully submits that its recited configuration, suitable for properly fastening the bare wire between the projecting plane and the second strip, is the result of careful, diligent, and purposeful research and experimentation, and is not something that one with ordinary skill in the field would know.

Hence, when considering both that (i) the selected relationship of the plate and notch widths is purposely selected and not readily known to those of ordinary skill, (ii) the selected relationship is not merely an inherent result of one of a plurality of possible formation processes (many of which would not inherently produce such a result); and (iii) the recited invention in no way relies on process steps (including especially the procedure cited by the Examiner), then it cannot reasonably be maintained that Applicant's apparatus of Claim 1 is rendered obvious on the basis of inherency.

Therefore, since all of the limitations of Claim 1 are not disclosed by the prior art either literally or by inherency, Applicant respectfully submits that Claim 1 of the present invention distinguishes over the art of record, and hence defines patentable subject matter.

Claims 2-3 depend from Claim 1. Accordingly, Applicant requests reconsideration and withdrawal of the rejection directed to Claims 2-3.

Claim 8 - Regarding independent Claim 8, Applicant believes this claim also distinguishes over the art of record for reasons generally similar to those set forth above for Claim 1.

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For the above reasons, Applicant respectfully requests reconsideration and withdrawal of the rejections under 35 USC §103, and further requests that the Examiner pass this case to issuance at the earliest opportunity.

Other Remarks

Applicant notes that any remarks, amendments, cancellations, or additions made herein are made solely for the purposes of more clearly and particularly describing and claiming the invention, and not for purposes of overcoming art or for patentability. The Examiner should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Examiner, not otherwise explicitly discussed.

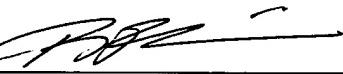
Furthermore, any remarks made with respect to a particular claim or claims shall be limited to only such claim or claims.

If the Examiner has any questions or comments that may be resolved over the telephone, he is respectfully requested to call the undersigned at (858) 675-1670.

Respectfully submitted,

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